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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/042,951 03/17/98 CHANG

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EXAMINER

LM12/0310

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ART UNIT

PAPER NUMBER

2744

DATE MAILED:

03/10/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/042,951

Applicant(s)

KIM CHANG et al.

Examiner

Sonny Trinh

Group Art Unit

2744



☒ Responsive to communication(s) filed on Jan 24, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1-20 is/are pending in the application

Of the above, claim(s) _____ is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-20 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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DETAILED ACTION

1. Applicant's arguments with respect to claims 1-20 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. **Claims 1-6** are rejected under 35 U.S.C. 103(a) as being unpatentable over Lupien (U.S. Patent number 6,006,091) in view of Coursey (U.S. Patent number 5,950,130).

4. As to **claim 1**, Lupien discloses A method in a cellular telecommunications network of informing the network of a plurality of operating capabilities of a mobile terminal. The method begins with the steps of entering an access (intermediate) state at the mobile terminal and then transmitting

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a message from the network to the mobile terminal requesting the mobile terminal to transmit information regarding the operating capabilities of the mobile terminal. Lupien further discloses the network or MSC transmits a request over the air to a mobile telephone to interrogate said mobile telephone's protocol capability (figures 1-2, column 4, line 52 to column 5, line 7). In response to a detection of said request, the mobile terminal responds with a protocol capability response message over the air (column 6, lines 30-67, table 1). Lupien further discloses the band, mode and capabilities of the mobile terminal are reported to the MSC (column 5, line 30 to column 6, line 67). However, Lupien does not disclose the customer service center, even though a customer service center is inherent in a wireless communication network, a reference is cited here for supporting Examiner's action. In an analogous art, Coursey discloses a mobile station with intelligent roaming and over the air programming features including a customer service center (CSC, Fig. 8, column 23, lines 4-17). At the time of the invention, it would have been obvious for a person skilled in the art to combine Lupien and Coursey to obtain the invention as claimed in claim 1; the motivation / suggestion for doing so would be to have the network activates the services requested by the mobile terminal without operator's intervention and to have a complete wireless telephone network.

5. As to **claim 2**, Lupien further discloses the analog band, digital cellular band, and the digital personal communication service (column 5, lines 30-56). It should be noted that the different frequency bands are defined by the FCC and it is obvious to comply with the FCC for compatibilities reasons.

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6. As to **claim 3**, Coursey further discloses the preferred roaming list (abstract, column 3, line 57 to column 4, line 4).

7. As to **claims 4-5**, Lupien further discloses the different service options that are available to the mobile telephone (table 1).

8. As to **claim 6**, Lupien further discloses the service option field (table 1) is utilized to initiate an appropriate provisioning of the mobile telephone (column 7, line 64 to column 8, line 49, and figures 1-2).

9. **Claim 7** is rejected under 35 U.S.C. 103(a) as being unpatentable over Lupien (U.S. Patent number 6,006,091), Coursey (U.S. Patent number 5,950,130) and in view of Cropper (U.S. Patent number 5,819,178).

10. As to **claim 7**, the combination of Lupien and Coursey discloses the invention except for the SERVICE OPTION field is utilized to initiate an appropriate provisioning of the Home Location Register (HLR). In an analogous art, Cropper discloses the methods and apparatus for accessing subscriber information in interconnected wireless telecommunications networks, Cropper further discloses that the HLR database includes subscriber data for mobile terminals provisioned on the first

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wireless network (Fig. 2, column 4, lines 19-34, claims 13-14). At the time of the invention, it would have been obvious for a person skilled in the art to combine Lupien, Coursey and Cropper to obtain the invention as claimed in claim 7; the motivation / suggestion for doing so would be to let the network know what kind of services the mobile station is capable of handling in order to better service it.

11. As to **claim 8**, Coursey further discloses the mobile telephone communication network may be a code division multiple access (CDMA) network (column 4, lines 21-38, column 11, lines 55-64).

12. As to **claims 9-16**, these claims merely reflect the apparatus to the method claim of claim 1-8 (respectively) and are therefore rejected for the same reasons.

13. As to **claims 17-20**, Coursey also set forth the mobile telephone aspect of claims 9-12 (Figs. bc) respectively and are therefore rejected for the same reasons.

Citation of Pertinent Prior Art

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

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Inventor	Publication	Number	Disclosure
Halonen	US Patent	5,887,254	Method and apparatus for updating the software of a mobile terminal using the air interface
Molne	US Patent	6,014,561	Method and apparatus for over the air activation of a multiple mode band radio telephone handset
Mills	US Patent	5,881,235	Remotely programming a mobile terminal with a home location register address

Conclusion

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

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or faxed to:

(703) 308-6306, (for formal communications intended for entry)

Or:

*(703) 308-6296 (for informal or draft communications, please label
"PROPOSED" or "DRAFT")*

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sonny Trinh whose telephone number is (703) 305-1961. The examiner can

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normally be reached Monday through Friday from 8:00 am to 4:30 pm, except on the first Friday of the bi-week.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-4700.

Sonny Trinh S.T.

March 1, 2000


DWAYNE D. BOST
SUPERVISORY PATENT EXAMINER
GROUP 2700

